

REMARKS/ARGUMENTS

Claims 15-28 are currently pending in this Application. In an Office Action mailed October 31, 2007, claims 20-28 were rejected, as claims 15-19 had been previously withdrawn.

In this Response, the Applicant has amended claims 20 and 26. The amendments to claims 20 and 26 are fully supported by the specification and do not add new matter. Accordingly, the Applicant requests reconsideration of the rejections in light of the above amendments and these remarks.

REJECTIONS

Claims 20-28 were rejected under 35 U.S.C. § 102(e) as purportedly being anticipated by Castro, U.S. Pat. No. 6,508,966 (“*Castro*”). Claims 20-28 were also rejected under § 102(b) as purportedly being anticipated by Osada, U.S. Pat. No. 6,162,236 (“*Osada*”). The Applicant respectfully traverses the rejections.

REJECTIONS § 102

As previously noted, claims 20-28 were rejected under § 102(e) as purportedly being anticipated by *Castro*. Applicant respectfully traverses that *Castro* discloses the presently claimed invention. Specifically, independent claims 20, 21 and 26 include elements that are neither disclosed nor suggested by *Castro*.

Indeed, claims 20, 21 and 26 all include the limitation of “a puncture tip.” *See*, claims 20, 21 and 26. A “puncture tip” allows for the trocar of the present invention to be inserted into a patient without need of an additional element. A device that does not require an additional element for insertion is beneficial in that it reduces concerns about sterilization and surgical errors. On the other hand, the device of *Castro* requires an additional element for the trocar to be inserted into the skin of the patient. *See, Castro*, col. 5 lines 3-17; *See also* Fig. 1. Since the

device requires an additional element to puncture the skin of a patient, it does not have a “puncture tip.” Therefore, since it does not disclose all of the limitations of the claims, *Castro* cannot anticipate the claims of the present invention.

Moreover, since independent claims 20, 21, and 26 are neither anticipated nor obvious in view of *Castro*, Applicant submits that the remaining dependent claims are all patentable in view of *Castro*.

In addition, claims 20-28 were also rejected under § 102(b) as purportedly being anticipated by *Osada*. Applicant respectfully traverse that *Osada* discloses the presently claimed invention. Specifically, independent claims 20, 21 and 26 include elements that are neither disclosed nor suggested by *Osada*.

As previously explained, independent claims 20, 21 and 26 include the limitation of “a puncture tip.” *See*, claims 20, 21 and 26. As with *Castro, supra*, *Osada* requires a trocar needle to break the skin thereby allowing the trocar tube to penetrate the skin. *See e.g. Osada*, col. 6, lns. 45-48. Absent the separate trocar needle, the trocar tube of *Osada* would be unable to penetrate the skin. Since *Osada* requires a separate trocar needle, *Osada* does not disclose a device with “a puncture tip.” Similarly, *Osada* does not suggest including a puncture tip in the disclosed device. Therefore, Applicant submits that the claims are neither anticipated nor obvious in view of *Osada*.

Additionally, *Osada* does not disclose additional limitations of independent claims 20, 21 and 26. All three independent claims include a limitation that splines are separated from adjacent splines by a separation. *See*, claims 20, 21 and 26, *supra*. Specifically, claim 20 includes the limitation that the separations traverse “a distance less than the length of the splines.” *See* claim 20. Claim 21 includes the limitation that the separations traverse “from the

puncture tip to a point less than a distance from the puncture tip to the retraction head.” *See* claim 21. Finally, claim 26 includes the limitation that the separations traverse “from the puncture tip to a point less than a distance from the tips to the heads.” *See* claim 26. Thus, all three independent claims include the limitation that separations are not as long as the splines, or in other words, a portion of the splines are attached to adjacent splines.

Osada does not disclose nor suggest this limitation. Specifically, *Osada* states that “the sides of adjacent strips are not secured to each other.” *Osada*, col. 3 ln 67 – col. 2 ln. 1. If the sides of the adjacent strips are not secured, then the separations between the strips are *as long as* the strips. However, the claims of the present application include the limitations, as noted above, that the separations are not as long as the splines. Therefore, *Osada* does not disclose all of the claimed limitations.

Moreover, since the strips of the device disclosed in *Osada* are completely separated from adjacent strips, the device requires an additional tube member to surround the strips. *See, Osada* col. 3 lns 64-66 (“The tubular portion 20 comprises a plurality of strips 23 which are arranged in a ring or a tube and an outer tube 24 which covers the surface of the strips.”). On the other hand, the claimed invention does not require an additional tube member. This is beneficial in that the device does not require additional pieces and material.

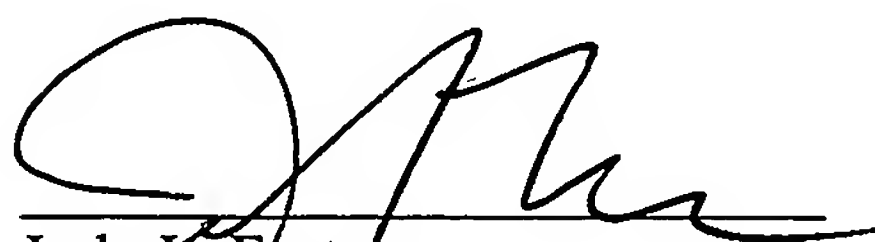
Since *Osada* does not disclose, nor suggest, each and every element of the claims, and therefore, Applicant submits that claims 20, 21 and 26 are patentable over *Osada*. Additionally, since the independent claims are patentable, Applicant respectfully submits that the remaining dependent claims are patentable in view of *Osada*.

Accordingly, in view of the above, Applicant submits that all pending claims are now in condition for allowance and respectfully requests reconsideration of the rejections and passage to issue.

Should anything further be required, a telephone call to the undersigned at (312) 226-1818 is respectfully invited.

Respectfully submitted,

FACTOR & LAKE, LTD.

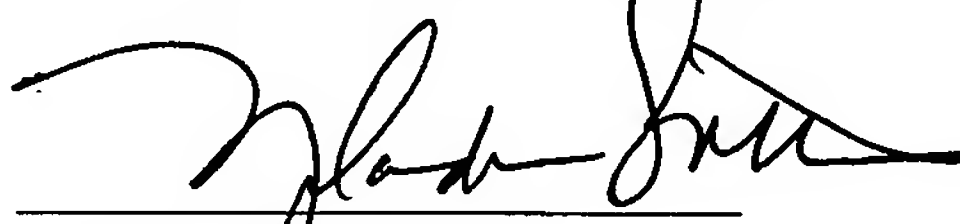


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Dated: February 8, 2008

CERTIFICATE OF MAILING

I hereby certify that this RESPONSE TO OFFICE ACTION is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on February 8, 2008.



Yolanda Solis